

Appl No. 10/031,225
Amdt. dated May 20, 2005
Reply to Office Action of March 23, 2005

REMARKS/ARGUMENTS

Claims 1-13 have been rejected. Claims 1-5, 8-12 and claim 6(amended), claim 7(amended) and claim 13(amended) remain in the case.

Claims 1, 2, and 7 are rejected as being unpatentable over the '442 patent of Orsellli in view of the '717 patent of Berkovi. Oselli discloses a roulette layout having a conventional inside part comprised of square betting areas and a conventional roulette wheel. Orsellli additionally discloses a random number generator. The outcome of a side bet is decided when a number provided by conventional roulette play is the same as a number provided by the random number generator.

Berkovi discloses a plurality of board games. In two of the games, a board carries numbered rectangles. In other games, the board carries numbered hexagons. Berkovi does not state a preference of using the hexagons over using the rectangles or vice versa.

Applicant's claim 1 calls for "[a] betting layout for a roulette game comprising an inside part with thirty six hexagonal betting areas..." Claim 2 depends from claim 1. Claim 7 also calls for the hexagonal betting areas. The position taken in the

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office action is that because of Berkovi, it is obvious to replace the square betting areas of Orselli with hexagonal betting areas. It should be understood that Orselli makes no mention or suggestion of hexagonal betting areas and Berkovi makes no mention or suggestion of roulette.

The rejection of Applicant's claim 1, 2 and 7 for obviousness is a product of hindsight which is explained hereinafter.

According to In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir., 04/28/1999), an express factual showing needs to exist in the record of a suggestion of a combination of references for a conclusion of obviousness. Quoting directly from Dembiczak: "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references... Combining prior art references without evidence of such a suggestion, teaching or motivation, simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight."

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In addition to a plethora of other case law, MPEP 2142 states the following:

"[t]he teaching or suggestion to make the claimed combination ... must...be found in the prior art, and not based on appellant's disclosure... To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention."

What the examiner in charge of the case has done is to ignore cases, such as Dembiczak, ignore substantial portions of the MPEP, and use appellants' disclosure as a roadmap through the prior art to formulate a rejection. Accordingly, the examiner has not made a *prima facie* case of obviousness. Therefore, claims 1, 2 and 7 are allowable over the ground of rejection.

Claims 3-6 and 8-13 are rejected under 35 U.S.C. 103(a) as unpatentable over Orselli in view of Berkovi and further in view of Danon.

Claims 3-6 depend from Claim 1 which has been shown to be allowable. Therefore, claims 3-6 are allowable.

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Claims 8, 9 and 12 depend from claim 7 which has been shown to be allowable. Therefore claims and 8, 9 and 12 are allowable.

Claims 10, 11 and 13 depend indirectly from claim 7. Therefore, claims 10, 11 and 13 are allowable.

Since claims 1-13 have been shown to be allowable, reconsideration of claims 1-13 and an early allowance thereof is hereby requested.

Respectfully submitted,

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